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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,911	11/20/2001	Victor I. Chomenky	P775 CON 3	6127

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MEDTRONIC AVE, INC.  
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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,411

Applicant(s)

Chomenty et al

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on March 18, 2003
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 31-46 is/are pending in the application.
- Of the above claim(s) 40 is is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 31-39 & 41-46 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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On March 18, 2003 the examiner contacted Ms. Catherine C. Maresh regarding the instant application, explaining that the preliminary amendments filed November 20, 2001 requested cancellation of all the pending claims and requesting amendments to claims which were not in the case. The examiner requested that a copy of the claims which were pending in the case be furnished, so that the case could be examined. However the copy of claims received on March 18, 2003 appear to be those contained in the amendment to the parent case filed on March 19, 2001 in response to the first office action in the parent case, while the claims submitted in the amendment filed November 20, 2001 in the instant case appear to correspond to the claim changes requested in the parent case in the amendment after final filed August 30, 2001.

While applicant has requested that the amendment "be reviewed in conjunction with the amendment filed November 20, 2001" the examiner notes that for the proposes of examination only. Claims 31, 34, 37-39, and 41 will be treated as filed in the amendment filed November 20, 2001 while the remaining claims (i.e. claims 32-33, 35, 36, 40, and 42-46) will be treated as filed in the amendment submitted March 18, 2003. In response to this office action applicant is required to submit an amendment clarifying exactly which claims are in the case and exactly what form they are in. The examiner notes that administratively it is improper to modify an amendment (i.e. that submitted March 18, 2003) using an earlier filed amendment (i.e. that submitted November 20, 2001). Thus the examiner suggests that in response to this office action applicant request that all pending claims be cancelled and that a new set of claims be filed beginning with claim number 47.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 31-39 and 41-46 are, drawn to a device for insertion in the body, classified in class 606, subclass 45.
- II. Claim 40, drawn to a method for conducting current, classified in class 607, subclass 116.

The inventions are distinct, each from the other because:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the device could be used outside the body.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Claim 40 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8, filed in parent case 09/123,669.

Claims 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Charms. Parker et al teach a device such as claimed except for the use of a

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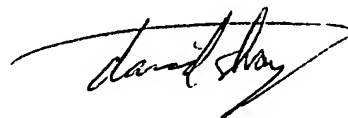
coaxial cable. Charms teach the equivalence of coaxial and non-coaxial cables to transmit electrical signals in catheters. Thus it would have been obvious to the artisan of ordinary skill to employ a coaxial cable in place of the non-coaxial cable of Parker et al, since these are recognized equivalents in the art, as taught by Charms thus producing a device such as claimed.

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Charms as applied to claims 31-39 are above, and further in view of Suzuki and Houston. Suzuki teaches boron nitride as a housing composition in an X-Ray tube. Houston teaches the equivalence of quartz and boron nitride as insulators. It would have been obvious to the artisan of ordinary skill to employ boron nitride in the housing of Parker et al, since these are equivalent as insulators, as taught by Houston and since it is appropriate for an x-ray tube housing, as taught by Suzuki, thus reducing a device such as claimed.

Any inquiry concerning this communication should be directed to david shay at telephone number 703-308-2215.

Shay/DI

March 24, 2003



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330